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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/601,077 | 06/20/2003 | William H. Fort | PCB105 | 7049 |
| 32047 | 7590 | 12/27/2005 | EXAMINER | |
| GROSSMAN, TUCKER, PERREAULT & PFLEGER, PLLC 55 SOUTH COMMERCIAL STREET MANCHESTER, NH 03101 | | | KRAUSE, JUSTIN MITCHELL | |
| | | ART UNIT | | PAPER NUMBER |
| | | 3682 | | |
| DATE MAILED: 12/27/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/601,077 | FORT ET AL. | |
| | Examiner | Art Unit | |
| | Justin Krause | 3682 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 02 November 2005.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) 14-20 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-13 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 16 January 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

The inventions are distinct, each from the other because of the following reasons:

1. Applicant's election without traverse of Group 1: Figures 1-3 in the reply filed on November 2, 2005 is acknowledged.

Applicant states claims 1-20 read on Group 1, claims 21 and 22 have been canceled.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, drawn to an actuator, classified in class 74, subclass 473.21.
- II. Claims 13-20, drawn to a method of locking a detent bracket in an out of park position, classified in class 74, subclass 473.25.

3. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the device can be used in a materially different way such as not locking a detent bracket in an out of park position.

4. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Donald Perreault on December 12, 2005 a provisional election was made without traverse to prosecute the invention of an actuator (Invention I), claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-20 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the spring that biases the plunger toward a retracted position when the solenoid is de-energized must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing

figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

8. Claim 2 is objected to because of the following informalities: "leaver" appears to be misspelled. It is being taken to be –lever—for examination purposes. Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 3, 5, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Mochida (US Patent 4,473,141).

Mochida discloses an actuator comprising:

-A latching lever (5 in combination with 13) pivotable between at least a first position (P) and a second position (R, N, D, D2, D1), said lever comprising a bearing surface (13).

-A stationary bearing surface (24)

-A solenoid (29) comprising a plunger (31) movable between an extended position and a retracted position (Figs 5a and 5b), wherein when said lever is disposed between said lever bearing surface and said stationary bearing surface thereby blocking said lever from pivoting to said second position, and when said plunger is in said retracted position said lever is not blocked from pivoting between said first position and said second position.

Regarding claim 3, the lever is biased toward one of said first and second position (31a, see Col. 3, lines 47-52).

Regarding claim 5, the plunger is biased toward one of said extended position and said retracted position when said solenoid is in an un-energized state (33, see Col. 3, lines 52-60).

Regarding claim 7, the actuator further comprises a mechanical switch (34) that is closed when said lever is in one of said first position and said second position.

Regarding claim 8, the plunger comprises a wedge shaped portion (31a).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mochida in view of Dörr et al (US Patent 5,379,872).

Mochida discloses all of the claimed limitations as described above.

Mochida does not disclose one of said lever bearing surface and said stationary bearing surface comprising a roller.

Dörr teaches an actuator with a roller (9), which allows the actuator to move with low forces (Col 4, lines 42-44).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Mochida and add a roller as taught by Dörr to one of, or both of the lever bearing surface (13) and the stationary bearing surface (24) to reduce friction (Col 3, line 15) and allow the actuator to be moved with low forces.

13. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mochida in view of Kataumi et al (US Patent 5,421,792).

Mochida discloses all of the claimed limitations as described above.

Mochida does not disclose the lever biased toward one of said first position and said second position by a torsion spring.

Kataumi teaches a torsion spring (46) to press a lever in the park position (Col 5, lines 28-32).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Mochida and add a torsion spring as taught by Kataumi in order to bias the latching lever towards a park position.

14. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mochida in view of Rolinski et al (US Patent 5,129,494).

Mochida discloses all of the claimed limitations as described above.

Mochida does not disclose the plunger being biased toward a retracted position by a compression spring when the solenoid is in an un-energized state.

Rolinski teaches a solenoid (201) with a push rod (242) which is biased to a retracted position (Column 9, lines 22-26) which holds the retaining lever (200) in a release position (Col 9, lines 27-28).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Mochida and bias the solenoid into a retracted position when the solenoid is un-energized, the motivation would have been allowing the lever to be moved when the solenoid is un-energized by not locking the lever into park.

15. Claim 9, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mochida in view of Dörr.

Mochida discloses an actuator comprising:

-A base plate (14) and all of the claimed limitations as described above

Mochida does not disclose a lever roller, stationary roller disposed on said base plate, and also does not show the plunger disposed between the lever roller and the stationary roller when the plunger is in an extended position and the lever is in a first position, preventing the lever from pivoting to a second position.

Dörr teaches an actuator with a lever roller (9) and a stationary roller (6), which allows the actuator to move with low forces (Col 4, lines 42-44).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Mochida and add a roller as taught by Dörr to one of, or both of the lever bearing surface (13) and the stationary bearing surface (24) to reduce friction (Col 3, line 15) and allow the actuator to be moved with low forces.

Inherently, by adding the stationary roller and lever roller to the device of Mochida, the plunger would be disposed between the lever roller and the stationary roller when the plunger is extended and the lever is in the first position, preventing the lever from pivoting to a second position.

Regarding claim 12, Mochida discloses a mechanical switch (34), which is closed when the lever is in the second position (Col 3, line 61 on).

Regarding claim 13, the plunger of Mochida comprises a wedge shaped portion (31a).

16. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mochida as modified by Dörr as applied to claim 9 above, and further in view of Kataumi et al.

Mochida as modified by Dörr discloses all of the claimed limitations as described above.

Mochida as modified by Dörr does not disclose the lever biased toward one of said first position and said second position by a torsion spring.

Kataumi teaches a torsion spring (46) to press a lever in the park position (Col 5, lines 28-32).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Mochida as modified by Dörr and add a torsion spring as taught by Kataumi in order to bias the latching lever towards a park position.

17. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mochida in view of Dörr as applied to claim 9 above, and further in view of Rolinski et al.

Mochida as modified by Dörr does not disclose the plunger being biased toward a retracted position by a compression spring when the solenoid is in an un-energized state.

Rolinski teaches a solenoid (201) with a push rod (242) which is biased to a retracted position (Column 9, lines 22-26) which holds the retaining lever (200) in a release position (Col 9, lines 27-28).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Mochida as modified by Dörr and bias the solenoid into a retracted position when the solenoid is un-energized, the motivation

would have been allowing the lever to be moved when the solenoid is un-energized by not locking the lever into park.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,127,245 discloses a park lock actuator

5,566,587 discloses a shift lock device

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin Krause whose telephone number is 571-272-3012. The examiner can normally be reached on Monday - Friday, 7:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMK
12/19/05


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